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ARMSTRONG WORLD INDUSTRIES, INC.
LEGAL DEPARTMENT
P. O. BOX 3001
LANCASTER PA 17604-3001

In re Application of
STACKENWALT et al.
Application No.: 10/774,234 (10/486,443)
Filing Date: 05 February 2004
Attorney's Docket No.: 0112
For: CANOPY-LIKE DECORATIVE
STRUCTURE

: DECISION ON
: PETITION
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This is in response to applicant's "Petition to Combine Files" filed in the United States Patent and Trademark Office (USPTO) on 06 May 2005.

BACKGROUND

On 19 July 2002, applicant filed international application PCT/US02/23040, which claimed priority of an earlier US application filed 19 July 2001.

On 05 February 2004, applicant filed a petition to revive the international application along with a Utility Patent Application, which was accompanied by, *inter alia*, the utility application filing fee of \$770, a specification and a declaration of the inventors. The application was assigned serial no. 10/486,443 and treated as a filing under 35 U.S.C. 371. Inadvertently, a second application file was created using the USPTO's Image File Wrapper (IFW) and assigned U.S. serial no. 10/774,234 to the papers filed on 05 February 2004.

On 29 March 2004, applicant's request for revival of the international application was granted. It is noted that international application PCT/US02/23040 was revived for purposes of continuity only and since continuity has been established by this decision reviving the international application, the international application is again abandoned in favor of the present continuing application 10/774,234. Although applicant provided a utility application as the proper reply under 37 CFR 1.137(b), the application was incorrectly processed as a national stage application under 35 U.S.C. 371(c).

On 06 May 2005, Petitioner filed the instant Petition to Combine Files requesting that the applications be combined into one file.

DISCUSSION

The transmittal letter filed on 05 February 2004 did not identify the application as a national stage application being filed under 35 U.S.C. 371. Applicant provided a utility application as the proper reply under 37 CFR 1.137(b). Accordingly, the papers should have been treated as a filing under 35 U.S.C. 111(a). Since the original papers deposited on 05 February 2004 did not seek treatment under 35 U.S.C. 371, the application is deemed to have been filed under 35 U.S.C. 111(a). International application PCT/US02/23040 was revived for

purposes of continuity only and since continuity has been established by this decision reviving the international application, the international application PCT/US02/23040 is now abandoned with respect to the United States in favor of the present continuing application 10/774,234.

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/774,234 and the international application (PCT/US02/23040) designating the United States were copending on 05 February 2004.

Applicant's request to combine files 10/774,234 and 10/486,443 is granted. All papers will be filed in U.S. application 10/774,234. Applicant will be refunded the basic filing fee of \$730 paid in application 10/486,443 to applicant's deposit account.

CONCLUSION

The specification and claims filed on 05 February 2004 met the requirements for granting a filing date for a filing under 35 U.S.C. 111(a) of 05 February 2004.

The petition to combine files is **GRANTED**. The application will be forwarded to OIPE for further processing, that is, for the transfer of all papers in U. S. application 10/486,443 into U.S. application 10/774,234. The basic filing fee of \$730 will be refunded to applicant's deposit account.

Applicant is advised to reference U.S. serial no. 10/774,234 in all future correspondence regarding this application.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Office of PCT Legal Administration

CMK/RRC:cmk

Telephone: (571) 272-3286
Facsimile: (571) 273-0459